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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:)
)
MORTON, FARAH) Art Unit: 3632
)
Serial No. 10/716,247) Examiner: Hewitt, James M.
)
For: PORTABLE INFANT BED)
)
Filed: November 17, 2003)
_____)

Certificate of Mailing

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Signed: _____

Deniece Turner

**STATUS REPORT
IN REISSUE APPLICATION (MPEP § 1410)**

Commissioner for Patents
5 Alexandria, VA 22313

Dear Sir:

This status report is submitted pursuant to the continuing duty of the applicant to disclose the status of court proceedings concerning the within application pursuant to MPEP
10 § 1410. On March 25, 2005, the Court of Appeals for the Federal Circuit denied the patentee's petition for rehearing, affirming the judgment of non-infringement of patent 6,370,715 entered by the U.S. District Court for the Eastern District of California.

A copy of the 16-page Memorandum and Order from the District Court dated March 17, 2004, and a copy of the 2-page Order from the Court of Appeals for the Federal Circuit dated March 25, 2005 are attached hereto. There was no challenge to the validity of the patent in these court proceedings, so no new documents or materials material to patentability were developed during the litigation.

Dated: September 23, 2005

Respectfully Submitted,

By



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FILED

MAR 17 2004

CLERK, U.S. DISTRICT COURT
EASTERN DISTRICT OF CALIFORNIA
BY _____

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF CALIFORNIA

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FARAH D. MORTON, an
individual, and BABY DELIGHT,
INC., a California
corporation,

Plaintiffs,

v.

THE FIRST YEARS, INC., a
Massachusetts corporation,

Defendant.

NO. CIV. S 03-2339 MCE DAD

MEMORANDUM AND ORDER

c/mce

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On Nov. 10, 2003, Plaintiffs Farah Morton and Baby Delight, Inc. (collectively "Morton") filed suit against Defendant The First Years, Inc. ("TFY"), claiming that TFY's product, the Close and Secure Sleeper ("CSS") infringes Morton's patent, U.S. Patent No. 6,370,715 ("the '715 patent").¹ On Nov. 20, 2003, Morton

¹ Morton requests the Court take judicial notice of the '715 patent, and included a copy of said patent in her request (continued...)

35

1 filed a motion seeking a preliminary injunction against TFY
2 enjoining the sale of CSS. TFY answered the complaint on
3 December 1, 2003, and on January 12, 2004, filed a counter-motion
4 for summary judgment of non-infringement. The matter is before
5 the court now on those two motions. As explained below, Morton's
6 motion for preliminary injunction is be DENIED, and TFY's motion
7 for summary judgment of non-infringement is GRANTED.

8 9 BACKGROUND

10
11 In 1999, Plaintiff Farah Morton developed a portable infant
12 bed designed to protect a baby when sleeping in the same bed as
13 adults, and also for use as a portable bed for the baby. She
14 applied for a patent on the invention in September of 1999, and
15 as a result the U.S. Patent and Trademark Office ("USPTO") issued
16 the '715 patent on April 16, 2002. Morton formed the corporation
17 Baby Delight, Inc. to market the bed, which she called the
18 "Snuggle Nest". Baby Delight, Inc. has an exclusive license to
19 manufacture, use, sell, and/or offer to sell any product covered
20 by the '715 patent. Morton Decl. ¶ 3.

21 In September of 2003, Morton attended the ABC Kid's Expo in
22 Las Vegas, Nevada. While there, she observed TFY advertising and
23 taking advance orders for CSS, a product they were preparing for
24 market. CSS was very similar to Morton's own Snuggle Nest, and
25

26
27 ¹(...continued)
28 for judicial notice. As the Court finds the '715 patent a proper
subject for judicial notice under Federal Rule of Evidence 201,
Morton's request is granted.

1 she believed CSS infringed her '715 patent. The primary
2 difference between the Snuggle Nest and CSS is that the side and
3 end walls on the Snuggle Nest are detachable while CSS is formed
4 of one piece of plastic such that the walls are not detachable.

5 As TFY was set to begin selling CSS in December of 2003,
6 Morton filed her patent infringement complaint on November 10,
7 2003, and this motion for preliminary injunction on November 20,
8 2003. TFY opposed this motion and filed its own counter-motion
9 for summary judgment of non-infringement on January 12, 2004.
10 Oral argument on these motions was heard on February 9, 2004. As
11 the Court finds as a matter of law that TFY's CSS does not
12 infringe the '715 patent, Morton's motion for preliminary
13 injunction is denied and TFY's motion for summary judgment is
14 granted.

15 16 STANDARD

17 18 1. Motion for Preliminary Injunction

19
20 Morton brings her motion for preliminary injunction under 18
21 U.S.C. § 283, which provides a district court jurisdiction to
22 grant injunctions "to prevent the violation of any right secured
23 by patent, on such terms as the court deems reasonable." As an
24 injunction issued under this section involves substantial matters
25 unique to patent law, the decision whether to issue such an
26 injunction is governed by the law of the United States Court of
27 Appeals for the Federal Circuit rather than that of the Ninth
28 Circuit. Hybritech Inc. v. Abbott Labs., 849 F.2d 1446, 1451

1 n.12 (Fed. Cir. 1988).

2 Under Federal Circuit law, when confronted with a request
3 for a preliminary injunction, the following "four factors are
4 evaluated in making the decision:

- 5 (1) The probability that the patentee will succeed on the
6 merits at trial;
7 (2) The irreparable harm to the patentee should the
8 injunction be denied;
9 (3) The balance of hardships between the patentee and the
10 defendant of granting or denying the injunction;
11 (4) The public interest."

12 Rhone-Poulenc Agrochime, S.A. v. Biagro W. Sales, Inc., No. CV-F-
13 94-5734, 1994 U.S. Dist. LEXIS 20574, at *6 (E.D. Cal. 1994)
14 (citing H.H. Robertson, Co. v. United Steel Deck, 820 F.2d 384,
15 387 (Fed. Cir. 1987)). No one factor is dispositive in this
16 evaluation; "rather, the district court must weigh and measure
17 each factor against the other factors and against the form and
18 magnitude of the relief requested." Hybritech, 849 F.2d at 1451.

19 2. Motion for Summary Judgment

20

21 The Federal Rules of Civil Procedure provide for summary
22 judgment when "the pleadings, depositions, answers to
23 interrogatories, and admissions on file, together with
24 affidavits, if any, show that there is no genuine issue as to any
25 material fact and that the moving party is entitled to a judgment
26 as a matter of law." Fed. R. Civ. P. 56(c). One of the
27 principal purposes of Rule 56 is to dispose of factually
28 unsupported claims or defenses. Celotex Corp. v. Catrett, 477

1 U.S. 317, 325 (1986).

2 Rule 56 also allows a court to grant summary adjudication on
3 part of a claim or defense. See Fed. R. Civ. P. 56(a) ("A party
4 seeking to recover upon a claim ... may ... move ... for a
5 summary judgment in the party's favor upon all or any part
6 thereof."); see also Allstate Ins. Co. v. Madan, 889 F. Supp.
7 374, 378-79 (C.D. Cal. 1995); France Stone Co., Inc. v. Charter
8 Township of Monroe, 790 F. Supp. 707, 710 (E.D. Mich. 1992).

9 The standard that applies to a motion for summary
10 adjudication is the same as that which applies to a motion for
11 summary judgment. See Fed. R. Civ. P. 56(a), 56(c); Mora v.
12 ChemTronics, 16 F. Supp. 2d 1192, 1200 (S.D. Cal. 1998).

13 Under summary judgment practice, the moving party
14 always bears the initial responsibility of informing
15 the district court of the basis for its motion, and
16 identifying those portions of 'the pleadings,
17 depositions, answers to interrogatories, and admissions
18 on file together with the affidavits, if any,' which it
19 believes demonstrate the absence of a genuine issue of
20 material fact.

21 Celotex Corp. v. Catrett, 477 U.S. at 323 (quoting Rule 56(c)).

22 If the moving party meets its initial responsibility, the
23 burden then shifts to the opposing party to establish that a
24 genuine issue as to any material fact actually does exist.

25 Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574,
26 585-87 (1986); First Nat'l Bank v. Cities Serv. Co., 391 U.S.
27 253, 288-89 (1968).

28 In attempting to establish the existence of this factual
dispute, the opposing party must tender evidence of specific
facts in the form of affidavits, and/or admissible discovery
material, in support of its contention that the dispute exists.

1 Fed. R. Civ. P. 56(e). The opposing party must demonstrate that
2 the fact in contention is material, i.e., a fact that might
3 affect the outcome of the suit under the governing law, and that
4 the dispute is genuine, i.e., the evidence is such that a
5 reasonable jury could return a verdict for the nonmoving party.
6 Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248, 251-52
7 (1986); Owens v. Local No. 169, Assoc. of Western Pulp and Paper
8 Workers, 971 F.2d 347, 355 (9th Cir. 1987). Stated another way,
9 "before the evidence is left to the jury, there is a preliminary
10 question for the judge, not whether there is literally no
11 evidence, but whether there is any upon which a jury could
12 properly proceed to find a verdict for the party producing it,
13 upon whom the onus of proof is imposed." Anderson, 477 U.S. at
14 251 (quoting Improvement Co. v. Munson, 14 Wall. 442, 448, 20
15 L.Ed. 867 (1872)). As the Supreme Court explained, "[w]hen the
16 moving party has carried its burden under Rule 56(c), its
17 opponent must do more than simply show that there is some
18 metaphysical doubt as to the material facts Where the record
19 taken as a whole could not lead a rational trier of fact to find
20 for the nonmoving party, there is no 'genuine issue for trial.'" Matsushita, 475 U.S. at 586-87.

22 In resolving a summary judgment motion, the evidence of the
23 opposing party is to be believed, and all reasonable inferences
24 that may be drawn from the facts placed before the court must be
25 drawn in favor of the opposing party. Anderson, 477 U.S. at 255.
26 Nevertheless, inferences are not drawn out of the air, and it is
27 the opposing party's obligation to produce a factual predicate
28 from which the inference may be drawn. Richards v. Nielsen

1 Freight Lines, 602 F. Supp. 1224, 1244-45 (E.D. Cal. 1985),
2 aff'd, 810 F.2d 898 (9th Cir. 1987).

4 ANALYSIS

6 1. Preliminary Injunction

8 The only element of the preliminary injunction test
9 seriously in dispute is that of Morton's likelihood of success on
10 the merits of her infringement case. As shown below, the Court
11 finds as a matter of law that TFY's product, CSS, does not
12 infringe on the '715 patent. Therefore, Morton will not succeed
13 on the merits. The Federal Circuit has explained that "case law
14 and logic both require that [Morton] cannot be granted a
15 preliminary injunction unless [she] establishes both of the first
16 two factors, i.e., likelihood of success on the merits and
17 irreparable harm." Amazon.com, Inc. v. Barnesandnoble.com, Inc.,
18 239 F.3d 1343, 1351 (Fed. Cir. 2001).

19 Accordingly, because Morton has not established a likelihood
20 of success on the merits of her infringement claim, her motion
21 seeking a preliminary injunction is denied.

23 2. Summary Judgment

25 In response to Morton's request for a preliminary
26 injunction, TFY seeks summary judgment that its CSS does not
27 infringe Morton's patent. "An infringement analysis requires two
28 separate steps. First, the court must construe the claims

1 asserted to be infringed as a matter of law in order to establish
2 their meaning and scope." Maxwell v. J. Baker, Inc., 86 F.3d
3 1098, 1105 (Fed. Cir. 1996) (citing Markman v. Westview
4 Instruments, Inc., 517 U.S. 370, 384 (1996)). The second step is
5 to compare claims as construed to the allegedly infringing
6 device. See id.

7 The dispute in this case centers around claim 1 of the '715
8 patent. Claim 1 describes a portable infant bed containing three
9 elements: (1) a support unit with detachable side and end walls
10 attached to a flat base, (2) a fabric cover, and (3) a
11 rectangular pad. It is only the support unit that is in question
12 here. "To prove infringement, [Morton] must show that the [CSS]
13 meets each claim limitation, either literally or under the
14 doctrine of equivalents." PSC Computer Prods., Inc. v. Foxconn
15 Int'l, Inc., 355 F.3d 1353, 1357 (Fed. Cir. 2004).

17 A. Literal Infringement

18
19 In order to find literal infringement, "the accused device
20 must contain every limitation of the asserted claim." Maxwell,
21 86 F.3d at 1105 (citing Laitram Corp. v. Rexnord, Inc., 939 F.2d
22 1533, 1535 (Fed. Cir. 1991)). Morton does not contend that the
23 CSS literally infringes any claim in the '715 patent. Claim 1 of
24 the '715 patent claims a bed with a support unit consisting of a
25 base and detachable walls. CSS does not have detachable walls;
26 the entire support unit is formed out of one piece of plastic.
27 Claim 2 of the '715 patent attempts to claim a support unit with
28 integral walls, but, as Morton concedes, it was erroneously

1 drafted as a claim dependent on Claim 1 rather than an
2 independent claim. Mot. Prelim. Inj. at 9, n.3. Therefore,
3 although it seems to indicate a support unit with integral walls,
4 claim 1 actually claims a support unit with detachable walls.
5 Since CSS does not contain detachable walls, it does not
6 literally infringe the '715 patent.

7
8 **B. Doctrine of Equivalents**
9

10 Although CSS "does not literally infringe, it may infringe
11 under the doctrine of equivalents if the differences between the
12 claimed invention and the accused device are 'insubstantial.'" Maxwell, 86 F.3d at 1105 (quoting Hilton Davis Chem. Co. v.
13 Warner-Jenkinson Co., 62 F.3d 1512, 1517 (Fed. Cir. 1995) (en
14 banc), rev'd on other grounds, 520 U.S. 17, 137 (1997)). As the
15 patentee, Morton "may invoke this doctrine to proceed against a
16 producer of a device 'if it performs substantially the same
17 function in substantially the same way to obtain the same
18 result'" as her patented device. Graver Tank & Mfg. Co., Inc. v.
19 Linde Air Prods., 339 U.S. 605, 608 (1950) (Graver II) (quoting
20 Sanitary Refrigerator Co. v. Winters, 280 U.S. 30, 42 (1929)).
21 "The theory on which [the doctrine of equivalents] is founded is
22 that 'if two devices do the same work in substantially the same
23 way, and accomplish substantially the same result, they are the
24 same, even though they differ in name, form, or shape.'" Id.
25 (quoting Union Paper Bag Mach. Co. v. Murphy, 97 U.S. 120, 125
26 (1877)).
27

28 The essential inquiry in determining whether the doctrine of

1 equivalents leads to a finding of infringement is: "Does the
2 accused product or process contain elements identical or
3 equivalent to each claimed element of the patented invention?"
4 Warner-Jenkinson Co. Inc. v. Hilton Davis Chemical Co., 520 U.S.
5 at 40. An element is "a discretely claimed component of a patent
6 claim." U.S. Patent and Trademark Office Glossary, available at
7 <http://www.uspto.gov/main/glossary/index>.

8 In this case, the relevant element is the support unit with
9 detachable sides. This, Morton claims, is equivalent to the
10 support unit of the CSS even though that unit has integral sides
11 which are not detachable. This argument has force if one looks
12 only at the product's main purpose, that of securing and
13 protecting a sleeping baby while in bed with adults. When used
14 in that way, Morton's Snuggle Nest is the functional equivalent
15 of the CSS. They both operate substantially the same way to
16 prevent an adult from inadvertently rolling over onto the child
17 and also to prevent the child from getting tangled in the bedding
18 or caught between the headboard and mattress. The fact that the
19 sides are or are not detachable does not affect this performance
20 in any substantial way.

21 However, the ability to detach the walls serves another
22 purpose altogether different from securing the baby. Morton also
23 promotes the invention protected by the '715 patent as a
24 comfortable bed for the baby to use for naps or while traveling.
25 To that end, the '715 patent describes the benefit of detachable
26 walls in the portability of the unit and in reducing its size for
27 easy storage when not in use. CSS, with integral walls, does not
28 share these beneficial attributes. To find equivalence, these

1 benefits must be ignored.

2 The '715 patent itself describes these benefits as
3 "important." col. 3, ln. 27-30. In fact, the Background of the
4 Invention section of the '715 patent describes the bassinet the
5 invention is designed to replace, and states that the walls that
6 protect the infant while sleeping also "make the bassinet bulky
7 and difficult to transport." '715 patent, col. 1, ln.26-27. The
8 claimed invention is touted as being "portable, and is especially
9 useful while traveling (in hotels, airports, while visiting
10 friends or relatives, day care, at the park, etc.) to provide a
11 familiar place for the infant to sleep." '715 patent, col. 2,
12 ln. 26-29.

13 With the emphasis on portability made within the language of
14 the patent itself, the key features in making the invention so
15 portable cannot be ignored. Thus, the fact that claim 1
16 specifies a support unit with detachable walls is a limitation on
17 claim 1 to include detachable walls in the support unit.

18 The authority Morton cites in her opposition and also her
19 surreply do not require a contrary holding. Those cases state
20 that insubstantial differences between a claimed invention and
21 the accused product can lead to a finding of equivalence even
22 though not every limitation in the patent is found literally in
23 the accused product. But nowhere does Morton point to a case in
24 which a limitation that represents an important benefit of the
25 invention was completely lacking in the accused product, yet
26 equivalence still found. That is the case here, and this Court
27 cannot find equivalence where the important benefits of the
28 detachable walls to portability and storage are lacking in CSS.

1 C. Dedication to the Public

2
3 TFY finally argues that even if the detachable walls are
4 somehow found to be equivalent to non-detachable walls, the use
5 of non-detachable walls was dedicated to the public through
6 disclosure, and since they were not claimed in the patent, cannot
7 be held infringing.

8 It is well established that "'subject matter disclosed but
9 not claimed in a patent application is dedicated to the public.'" Maxwell v. J. Baker, Inc., 86 F.3d 1098, 1106 (Fed. Cir. 1996)
10 (quoting Unique Concepts, Inc. v. Brown, 939 F.2d 1558, 1562-63
11 (Fed. Cir. 1991)); see also Miller v. Bridgeport Brass Co., 104
12 U.S. 350, 352 (1881) ("[T]he claim of a specific device or
13 combination, and an omission to claim other devices or
14 combinations apparent on the face of the patent, are, in law, a
15 dedication to the public of that which is not claimed."). This
16 rule applies to both literal infringement and equally to
17 infringement under the doctrine of equivalents. J. Baker, 86
18 F.3d at 1107. The rationale behind the rule is that the patentee
19 should not be permitted to "write narrow claims for allowance by
20 the [USPTO] and subsequently attempt to broaden the claims in
21 court by using the doctrine of equivalents." PSC Computer
22 Prods., 355 F.3d at 1357.

23
24 Morton concedes that non-detachable walls were inadvertently
25 left unclaimed because claim 2 was written as a dependant claim.
26 No argument has been made that claim 2 should be read as an
27 independent claim or that CSS infringes any claim other than
28 //

1 claim 1. As written, claim 2 is dependent on claim 1.²
2 According to the USPTO, a "dependent claim" is "a claim that
3 refers back ('depends on') to and further limits a preceding
4 dependent or independent claim. A dependent claim shall include
5 every limitation of the claim from which it depends."
6 <http://www.uspto.gov/main/glossary/index.html#e>. Additionally,
7 Morton concedes that the accused product, CSS, does not literally
8 infringe any claim in her patent. Mot. Prelim. Inj. at 9, n.3.

9 A support unit with integral walls, as compared to one with
10 detachable walls, is disclosed in the Summary of the Invention,
11 '715 Patent, Col. 1, ln. 64-65, and in the Detailed Description
12 of the Preferred Embodiments, '715 Patent, Col. 4, ln. 15-19.
13 Therefore, unless the '715 patent effectively claims a support
14 unit with integral walls, Morton dedicated the use of a support
15 unit with integral walls to the public. As explained above, the
16 '715 patent does not claim such a support unit, and therefore it
17 was dedicated to the public.³ Accordingly, the use of a support
18 unit with integral walls cannot, as a matter of law, be held to
19 infringe Morton's patent.

20 Morton contends that her failed attempt to claim a support
21 unit with integral walls in claim 2 of the '715 patent somehow
22 prevents such a support unit from being dedicated to the public.

23
24 ² Claim 2 reads: "The infant bed of claim 1 wherein said
25 base panel, end wall and side walls are integrated into a single
unit." '715 patent, col. 5, ln 38-39.

26 ³ A support unit with integral walls might be within
27 claim 7, which is silent as to whether the walls are detachable
28 or integrated into the support unit. Claim 7 contains a
limitation that requires a plurality of openings for receiving
suction cups. CSS contains no such openings, and Morton does not
argue that CSS infringes claim 7.

1 According to Morton, the fact that she tried to claim such a
2 support unit shows she did not intend to dedicate a one-piece
3 support unit to the public. This argument misses the mark.

4 Patent law is clear as to the recourse available to a
5 patentee that fails to effectively claim an invention. "Within
6 two years from the grant of the original patent, a patentee may
7 file a reissue application and attempt to enlarge the scope of
8 the original claims to include the disclosed but previously
9 unclaimed subject matter." R.E. Service Co., 285 F.3d at 1055.

10 Morton has already filed such a reissue application to correct
11 claim 2. Should that application be granted, TFY concedes that
12 CSS would be within the scope of claim 2 of the '715 patent, and
13 therefore be literally infringing upon it. However, that does
14 not enter into the decision faced by this Court. For even if the
15 '715 patent is reissued, TFY would not be prevented from
16 producing CSS.

17 Patent law specifically addresses this effect of patent
18 reissue in 35 U.S.C. § 252. In the event the '715 patent is
19 reissued, it will be reissued with an effective date the same as
20 that of the original issue. However, anyone who has made a
21 product that would be infringing of the patent as reissued but
22 not of the patent as originally issued is not affected by the
23 reissue. 35 U.S.C. § 252. They are, in effect, "grandfathered
24 in", and may continue to produce the now-infringing item. Thus,
25 even if CSS would be infringing of the '715 patent if it is
26 reissued, TFY would be permitted to continue to produce CSS.
27 Therefore, the potential effect of reissuing the '715 patent with
28 claim 2 stated as an independent claim rather than a dependent

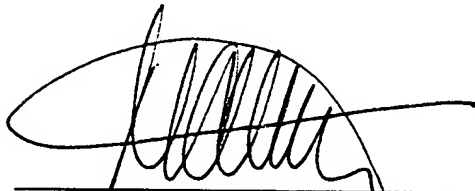
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CONCLUSION

For the reasons more fully explained above, Morton's motion for a preliminary injunction is DENIED. TFY's motion for summary judgment of non-infringement is GRANTED.

IT IS SO ORDERED.

DATED: MAR 16 2004



MORRISON C. ENGLAND, Jr.
UNITED STATES DISTRICT JUDGE

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

04-1308

FARAH D. MORTON and BABY DELIGHT, INC.,

Plaintiffs-Appellants,

v.

THE FIRST YEARS, INC.,

Defendant Appellee.

ORDER

United States Court of Appeals for the Federal Circuit

O R D E R

A combined petition for panel rehearing and for rehearing en banc having been filed by the APPELLANTS, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc having been referred to the circuit judges who are in regular active service,


UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for panel rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on April 1, 2005.

FOR THE COURT,


Jan Horbaly
Clerk

Dated: March 25, 2005

cc: Mark D. Miller
John M. Skenyon

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

MAR 25 2005

JAN HORBALY
CLERK

MORTON V THE FIRST YEARS, 04-1308
(DCT - 03-CV-2339)

*
* Note: Pursuant to Fed. Cir. R. 47.6, this order is not *
* citable as precedent. It is a public record. *
*
